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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/631,170  | 07/31/2003  | Janice M. Golda      | ITL.1019US (P16706) | 1421             |
| 21906   | 7590        | 11/16/2005           | EXAMINER            |                  |
| TROP PRUNER & HU, PC<br>8554 KATY FREEWAY<br>SUITE 100<br>HOUSTON, TX 77024 |             |                      | PICKETT, JOHN G     |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3728                |                  |

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Tata

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/631,170             | GOLDA, JANICE M.    |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Gregory Pickett        | 3728                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,21-23 and 25-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,6,7,23 and 27-33 is/are rejected.
- 7) ☒ Claim(s) 2,5,21,22,25 and 26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 28 July 2005 has been entered. Claims 1, 2, 4-7, 21-23, 25-33 are pending in the application.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 103***

3. Claims 1, 4, 6, 7, 23, and 27-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angelopoulos et al (US 6,543,617) and either Merkle (US 2,467,268) or Nazaroff et al (US 5,061,444).

Claims 1 and 7: It must be noted that the active steps of the claimed method is the provision of two structures: the reticle on a carrier inside an antistatic bag, and a self-contained thermophoretic source. The claim does not provide for a proximity of the two structures, but merely that the thermophoretic source be external to the carrier. The terminology "to protect said reticle from particle contamination" is deemed insufficient since it does not set forth how the active step of the provision of structure, without any

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sort of proximity, protects the reticle. It has been held that to be entitled to weight in method claims, the recited structure limitations must affect the method in a manipulative sense, and not amount to the mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 1962 C.D. 408 (1961). As such, the claim amounts to the claiming of the mere existence of the two structures.

A reticle is a photo-mask used in a stepper. Angelopoulos et al discloses a reticle **1** (see for example Col. 5, lines 12-16) on a carrier **3** inside an antistatic bag **4** (see for example, Example 5) for the storage of long term storage of the reticle, and for said purpose, its provision would have been obvious.

Merkle discloses a self-contained thermophoretic source **28** for transportation of perishable items and its provision for said purpose would have been obvious. Nazaroff et al discloses a thermophoretic source (see for example Col. 7, lines 16-19). As neither Merkle, Nazaroff et al, nor Angelopoulos et al discloses the use of the structures together, it would have been obvious to provide the structures separate. As such, the thermophoretic sources would be external to carrier **3**.

Claim 4: thermophoretic source **28** of Merkle is dry ice.

Claim 6: Nazaroff et al discloses a Peltier source (see for example Col. 7, lines 16-19).

Claims 23, 27-31: The active steps of the claimed method is the provision of structure in the provision of a reticle on a carrier inside an antistatic bag, and creating a temperature gradient within a shipping box. The claim does not provide for the reticle located within the box. The terminology "to protect said reticle from particle

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contamination" is deemed insufficient since it does not set forth how the active step of the creation of a temperature gradient within a shipping box, without placement of the reticle within the shipping box, protects the reticle. It has been held that to be entitled to weight in method claims, the recited structure limitations must affect the method in a manipulative sense, and not amount to the mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 1962 C.D. 408 (1961). As such, the claim amounts to the claiming of the mere existence of the two structures.

A reticle is a photo-mask used in a stepper. Angelopoulos et al discloses a reticle 1 (see for example Col. 5, lines 12-16) on a carrier 3 inside an antistatic bag 4 (see for example, Example 5) for the storage of long term storage of the reticle, and for said purpose, its provision would have been obvious.

Merkle discloses a self-contained thermophoretic source 28 within a shipping box 2 that inherently produces a temperature gradient upon its initial insertion, for transportation of perishable items and its provision for said purpose would have been obvious. Nazaroff et al discloses a thermophoretic source (see for example Col. 7, lines 16-19). As neither Merkle, Nazaroff et al, nor Angelopoulos et al discloses the use of the structures together, it would have been obvious to provide the structures separate. As such, the thermophoretic sources would be external to carrier 3.

Claims 32 and 33: The active steps of the claimed method is the provision of structure in the provision of a reticle on a carrier inside an antistatic bag, and provision of a thermophoretic source within a shipping container. The claim does not provide for the reticle within the container. The terminology "to prevent particles from

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contaminating said reticle" is deemed insufficient since it does not set forth how the active step of providing a thermophoretic source within a shipping container, without placement of the reticle within the shipping container, protects the reticle. It has been held that to be entitled to weight in method claims, the recited structure limitations must affect the method in a manipulative sense, and not amount to the mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 1962 C.D. 408 (1961). As such, the claim amounts to the claiming of the mere existence of the two structures.

A reticle is a photo-mask used in a stepper. Angelopoulos et al discloses a reticle 1 (see for example Col. 5, lines 12-16) on a carrier 3 inside an antistatic bag 4 (see for example, Example 5) for the storage of long term storage of the reticle, and for said purpose, its provision would have been obvious.

Merkle discloses a self-contained thermophoretic source 28 within a shipping box 2 that inherently produces a temperature gradient upon its initial insertion, for transportation of perishable items and its provision for said purpose would have been obvious. As neither Merkle nor Angelopoulos et al discloses the use of the structures together, it would have been obvious to provide the structures separate. As such, the thermophoretic sources would be external to carrier 3.

#### ***Allowable Subject Matter***

4. Claims 2, 5, 21, 22, 25, and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

### ***Response to Arguments***

6. The previous indicated allowability of claim 24 was withdrawn in view of a more broad interpretation of the claim. The claim (as amended into independent form into claim 23) does not provide for the reticle within the container. The amendment to claim 1, incorporating the subject matter of claim 3 (previously indicated allowable), fails to incorporate the subject matter of claim 2 upon which claim 3 was dependent. The amended claim does not provide for proximity of the two structures. Claim 32 does not provide for the reticle within the shipping container.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Greg Pickett  
Examiner  
10 November 2005

  
**JILA M. MOHANDESI**  
**PRIMARY EXAMINER**